

### REMARKS

Claims 1-2 were examined. Claims 1-2 remain in the application. Reconsideration of the pending claims is respectfully requested in view of the above amendments and the following remarks.

A. 35 U.S.C. §101: Rejection of Claims 1 & 2

The Patent Office rejects claims 1 and 2 under 35 U.S.C. §101. Applicants believe the claims as amended overcome the rejection. Applicants respectfully request that the Patent Office withdraw the rejection to claims 1 and 2 under 35 U.S.C. §101.

B. 35 U.S.C. §112, First Paragraph: Rejection of Claims 1 & 2

The Patent Office rejects claims 1 and 2 under 35 U.S.C. §112, first paragraph. Applicants advise the Patent Office that the microorganism strains *YS-44442* and *YS-43494* were deposited January 7, 2002 at the China Center for Type Culture Collection (CCTCC) under Accession Nos. M202001 and M202002, respectively. See Application at page 5, lines 2-4 and page 26, lines 8-10. Applicants include herewith a Declaration by William Thomas Babbitt, an attorney of record, stating that the deposit was made under the terms of the Budapest Treaty and that all restrictions imposed by the Depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent.

Applicants respectfully request that the Patent Office withdraw the rejection to claims 1 and 2 under 35 U.S.C. §112, first paragraph.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 9/15/03

William T. Babbitt  
William Thomas Babbitt, Reg. No. 39,591

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, California 90025  
(310) 207-3800

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Nedy Calderon 9/15/03  
Nedy Calderon Date

## AMENDMENTS TO THE SPECIFICATION

Please amend the Specification as follows:

Page 4, lines 21-24 to page 5, lines 1-4:

One object of the invention is to provide two new microorganism strains for producing pravastatin in a good yield. The inventors surprisingly obtained two novel microorganism strains, *YS-44442* and *YS-45494*, through the isolation of actinomycetes from soil samples, showing a high tolerance to compactin and a high productivity of pravastatin. The two strains were deposited with the China Center for Type Culture Collection (CCTCC) under the accession number of M202002 and M202002, respectively, ~~on 8 January 2002~~ on 7 January 2002.

Page 26, lines 4-10:

Based on the combined results of phylogenetic and physiological analyses, we believe strains *YS-44442* and *YS-45494* are distinct from one another and from the type strains of *Saccharothrix aerocolonigenes*, *Saccharothrix australiensis*, and *Saccharothrix texasensis* and are novel species of the genus *Saccharothrix*. The two strains were deposited with the China Center for Type Culture Collection (CCTCC) and given the accession number of M202001 and M202002, respectively, ~~on 8 January 2002~~ on 7 January 2002.

## AMENDMENTS TO THE CLAIMS

1. (Currently amended) ~~A~~An isolated microorganism strain *YS-44442* of *Saccharothrix* and the mutant thereof.
2. (Currently amended) ~~A~~An isolated microorganism strain *YS-45494* of *Saccharothrix* and the mutant thereof.
3. (Withdrawn) A process for producing pravastatin using the microorganism of Claim 1 or 2.
4. (Withdrawn) The process of Claim 3, comprising the steps of (a) cultivating the microorganism of Claim 1 or 2 at a suitable condition to generate a fermentation broth; (b) feeding compactin into the broth; (c) fermenting the broth for a period of time to convert the compactin to pravastatin; and (d) isolating the pravastatin from the broth.
5. (Withdrawn) The process of Claim 4, wherein the fermentation broth of Step (a) is cultivated for less than 2 days.
6. (Withdrawn) The process of Claim 5, wherein the fermentation broth of Step (a) is cultivated for about 18 hours.
7. (Withdrawn) The process of Claim 4, wherein the fermentation broth of Step (a) is derived from a seed culture of the microorganism which is cultivated at a suitable condition for about 18 to about 48 hrs before inoculation into the broth.
8. (Withdrawn) The process of Claim 4, wherein the compactin of Step (b) is fed into the broth at a final concentration of higher than 1.0 g/L.

9. (Withdrawn) The process of Claim 8, wherein the final concentration is about 1.5 to about 2.0 g/L.
10. (Withdrawn) The process of Claim 4, wherein the period of time of Step (c) to convert the compactin to the pravastatin is less than 5 days.
11. (Withdrawn) The process of Claim 10, wherein the period of time is less than 3 days.
12. (Withdrawn) The process of Claim 11, wherein the period of time is less than 24 hours.
13. (Withdrawn) A process of isolating pravastatin, comprising the steps of (1) adding an ammonium sulfate into a first solution containing the (HMG)-CoA reductase inhibitor to produce a precipitation; (2) isolating the precipitation; (3) dissolving the precipitation with a polar solvent to produce a second solution; (4) adjusting the pH of the second solution to about pH 4 to about PH 6; and (5) extracting the second solution with an water immiscible solvent to isolate the (HMG)-CoA reductase inhibitor.
14. (Withdrawn) The process of Claim 13, wherein the (HMG)-CoA reductase inhibitor is selected from pravastatin, compactin and lovastatin.
15. (Withdrawn) The process of Claim 14, wherein the (HMG)-CoA reductase inhibitor is pravastatin.
16. (Withdrawn) The process of Claim 13, wherein the first solution of Step (1) is a microbial fermentation broth.
17. (Withdrawn) The process of Claim 16, wherein the microbial fermentation broth is derived from a microorganism capable of producing the (HMG)-CoA reductase inhibitor, said microorganism is selected form *Streptomyces roseochromogenus*, *Actinomadura*, *Aspergillus*, *Monascus*, *Penicillium*, *Paecilomyces*, *Hypomyces*, *Phoma*, *Pleurotus*, *Doratomyces*, *Eupenicillium*,

*Gymnoaxus*, *Trichoderma*, YS-44442 of Claim 1, YS-45494 of Claim 2, and the mutants thereof.

18. (Withdrawn) The process of Claim 13, wherein the ammonium sulfate of Step (1) is added into the first solution in an amount of 30 to 60 % (w/v) of the first solution.

19. (Withdrawn) The process of Claim 18, wherein the ammonium sulfate is added to be saturated in the first solution.

20. (Withdrawn) The process of Claim 13, wherein the water immiscible solvent of Step (5) is an organic solvent.

21. (Withdrawn) The process of Claim 20, wherein the organic solvent is selected from ethyl acetate, acetone, toluene, dichloromethane and isopropyl acetate.

22. (Withdrawn) The process of Claim 21, wherein the organic solvent is ethyl acetate.

23. (Withdrawn) The process of Claim 13, further comprising a step of reacting the isolated (HMG)-CoA reductase inhibitor with an organic or inorganic cation source to generate a salt form of the inhibitor.

24. (Withdrawn) The process of Claim 23, wherein the cation source is a sodium source.

25. (Withdrawn) The process of Claim 24, wherein the sodium source is selected from NaOH, Na<sub>2</sub>CO<sub>3</sub>, sodium acetate (anhydrous) and sodium-2-ethyl hexanoate.

# **CHINA CENTER FOR TYPE CULTURE COLLECTION**

Wuhan University, Wuhan 430072 P. R. China Fax: (027)87883833, E-mail: cctcc@whu.edu.cn

## **BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE**

### **TO: (Name and Address of Depositor or Attorney)**

Yung Shin Pharm. Ind. Co., Ltd., Taiwan

Deposited on Behalf of:

Ntd Patent and Trademark Agency Limited

Identification Reference by Depositor:

Saccharothrix sp. 44442

CCTCC Designation:

CCTCC M 202001

The deposit was accompanied by: \_\_\_\_\_ a scientific description ☒ a proposed taxonomic description indicated above.

The deposit was received January 7, 2002 by this International Depository Authority and have been accepted.

### **AT YOUR REQUEST:**

We will inform you of requests for the strain for 30 years.

The strain will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive.

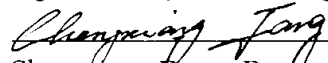
If the culture should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace it with living culture of the same.

The strain will be maintained for a period of at least 30 years after the date of deposit, and for a period of at least five years after the most recent request for a sample.

The viability of the culture cited above was tested January 28, 2000. On that date, the culture was viable.

International Depository Authority: China Center for Type Culture Collection (CCTCC).

Signature of person having authority to represent CCTCC:

 Date: January 28, 2000  
Chengmang Fang, Deputy Director of CCTCC

# **CHINA CENTER FOR TYPE CULTURE COLLECTION**

Wuhan University, Wuhan 430072 P. R. China Fax: (027)87883833, E-mail: cctcc@whu.edu.cn

## **BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE**

### **TO: (Name and Address of Depositor or Attorney)**

Yung Shin Pharm. Ind. Co., Ltd., Taiwan

Deposited on Behalf of:

Ntd Patent and Trademark Agency Limited

Identification Reference by Depositor:

Saccharothrix sp. 45494

CCTCC Designation:

CCTCC M 202002

The deposit was accompanied by: \_\_\_\_\_ a scientific description ☒ a proposed taxonomic description indicated above.

The deposit was received January 7, 2002 by this International Depository Authority and have been accepted.

### **AT YOUR REQUEST:**

We will inform you of requests for the strain for 30 years.

The strain will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive.

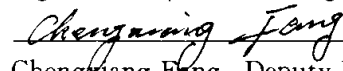
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International Depository Authority: China Center for Type Culture Collection (CCTCC).

Signature of person having authority to represent CCTCC:



Date: January 28, 2000

Chengxiang Fang, Deputy Director of CCTCC



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Fang-Yu Lee, et al.

Application No. 10/085,871

Filed: 02/27/2002

For: STRAINS OF SACCHARAOTHRIX, PROCESS  
FOR PRODUCING PRAVASTAIN USING THE  
STRAINS AND ISOLATION PROCESS OF  
(HMG)-COA REDUCTASE

Examiner: Herbert J. Lilling

Art Unit 1651

Confirmation No. 7742

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

DECLARATION OF WILLIAM THOMAS BABBITT

Dear Sir:

I, William Thomas Babbitt, do hereby declare as follows:

1. I am an attorney of record for the above-referenced application.
2. I am informed that the microorganism strains *YS-44442* and *YS-45494* were deposited on January 7, 2002 (prior to the filing date of February 27, 2002) with the China Center for Type Culture Collection (CCTCC) under the Budapest Treaty, and under accession numbers M202001 and M202002, respectively. Copies of deposit certificates for each deposit are attached as Exhibit A.
3. All restrictions imposed by depositor Yung Shin Pharm. Ind. Co., Ltd., on the availability to the public of the deposited strains will be irrevocably removed upon the granting of a patent.

I declare under penalty of perjury that the foregoing is true and correct and that all statements made herein are of my own knowledge and true and all statements made on information and belief are believed to be true; further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of United States Code and that such willful statements may jeopardize the validity of the application or any patents issued thereon.

Respectfully submitted,

Date: 9/15/03

William T Babbitt  
William Thomas Babbitt, Reg. No. 39,591

BLAKELY SOKOLOFF TAYLOR & ZAFMAN, LLP  
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Los Angeles, California 90025  
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Nedy Calderon 9/15/03  
Nedy Calderon Date